

REMARKS:

Claims 1-11, 34, and 35 remain in the application for consideration.

Claims 1-11 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-11, 34, and 35 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,338,067 to Baker, et al. These rejections are respectfully traversed for the reasons discussed below.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-11 stand rejected under 35 U.S.C. § 112, second paragraph.

Applicant maintains that claims 1-11 are in compliance with the requirements of 35 U.S.C. § 112 as set forth in the Amendment filed on 16 August 2005.

While it is noted that the Office Action alleges that the remarks presented in the 16 August 2005 “do not clarify the matter,” it is respectfully submitted that merely referencing the original rejection (“Applicant is directed towards the May 19, 2005 Non-final Office Action, paragraph 3, regarding the body of the rejection”), rather than providing an explanation or clarification in view of Applicants remarks, does not clarify the matter either.

For the convenience of the Examiner, the remarks presented in the 16 August 2005 Amendment regarding the rejection under 35 U.S.C. § 112 are reproduced below.

The Office Action indicates that the reason for this rejection is a pair of phrases recited in claim 1: “seller database being one of a plurality of seller databases” and “all seller databases in the plurality of seller databases.” The Office Action alleges that these two phrases render the scope unclear because they “improperly intermix a singular database in juxtaposition with a plurality of databases.” This allegation is respectfully traversed.

There is no basis or authority cited for supporting the notion that it is improper to “intermix a singular database in juxtaposition with a plurality of databases.” Thus, it is

respectfully submitted that the allegation that “intermix[ing] a singular database in juxtaposition with a plurality of databases” renders the claim unclear is without merit.

Further, the phrases in question have been singled out without consideration for the context in which the phrases are presented within the claim. Note that MPEP 2173.02 instructs that “[i]n reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim *as a whole*....” (Emphasis added). The phrases in question are presented in claim 1 as follows:

a content enhancement module operable to:

analyze product data stored in a seller database using one or more rules, the seller database being one of a plurality of seller databases, the rules comprising one or more generic rules applying to substantially all seller databases in the plurality of seller databases that store product data,

Thus, claim 1 recites a plurality of seller databases comprising a seller database (“the seller database being one of a plurality of seller databases”), the product data of the seller database being analyzed using one or more rules (“analyze product data stored in a seller database using one or more rules”), the one or more rules comprising one or generic rules that apply to substantially all of the plurality of seller databases (“the rules comprising one or more generic rules applying to substantially all seller databases in the plurality of seller databases that store product data”). It is respectfully submitted, therefore, that the claim is setting forth rules and generic rules, where the rules apply to a certain seller database that is one of plural databases whereas the generic rules apply to more than one database, and where the rules include one or more of the generic rules, and that this recitation would be at least reasonably clear to one of ordinary skill in the art.

In light of the above, it is respectfully submitted that claims 1-11 are fully compliant with the requirements of 35 U.S.C. § 112. Accordingly, it is respectfully requested that the rejection of claims 1-11 under 35 U.S.C. § 112 be reconsidered and withdrawn.

In the event that the Examiner remains unconvinced, the Examiner is invited to contact the undersigned Agent for Applicant by telephone at (817) 447-9955 so that the issue can be discussed and a resolution can be reached.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-11, 34, and 35 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,338,067 to Baker, et al. ("Baker"). However, because Baker fails to disclose or suggest all of the limitations of claims 1-11, 34, and 35, Baker cannot render these claims obvious.

Applicant maintains that Baker fails to render the present claims obvious for reasons presented in the Amendment filed 16 August 2005. Response to the specific comments presented in the present Office Action are provided below.

As a preliminary note, it is respectfully pointed out that "the examiner bears the initial burden of presenting a prima facie case of obviousness."¹

The Office Action states that "only one rule need be present to fully meet Applicant's claim language. This rule may be no more than recognizing the characters of the product data that is analyzed by Baker." However, it is respectfully submitted that since Baker fails to disclose or suggest such a rule, this hypothetical statement is of no consequence. It is noted that no portion of Baker is cited to support the notion that Baker teaches such a rule. Clarification is therefore respectfully requested.

The Office Action further states "the analysis executed by Baker meets in broad scope and content this terminology for one of ordinary skill in the art." First, it is unclear what "analysis" in Baker is being referenced since no reference to Baker is provided. Second, Applicants respectfully disagree that there is anything in Baker to suggest the claimed invention. It is noted that this statement is merely conclusory and provides no reasons to support the conclusion. Clarification is therefore respectfully requested.

The Office Action further states that "[t]his analogy is similar to claim 34 'means for' terminology." However, no analogy is found, so clarification is respectfully requested.

The Office Action further states that "[r]egarding claim 35 'a search interface operable to communicate [a] speech [sic: search] query for product data to a seller

database' may be no more that [sic] the web page interfacing over the Internet." First, this statement is respectfully traversed as being contrary to fact (e.g., a "web page interfacing over the internet" does not necessary or inherently have the requisite access to a seller database). Second, the statement stops short of providing an explanation as to how Baker is considered to disclose or suggest the claim limitation in question. Clarification is therefore respectfully requested.

The Office Action further states that "intended use claim language, e.g. "if two" or "operable to" is given less patentable weight..." In response, Applicants first respectfully disagree with the allegation that "if two" or "operable to" indicates "intended use." It is noted that there is no basis or authority cited to support this allegation. Clarification is therefore respectfully requested.

The Office Action further states that "it appears Baker meets in broad scope and content this intended use claim language." First, Applicant reiterates that the claim language is not merely indicative of an "intended use." Second, it does not appear to Applicant that Baker meets in broad scope and content all of the claim limitations for reasons discussed above and in the 16 August 2005 Amendment. Clarification is therefore respectfully requested. It is noted that this statement is merely conclusory and provides no reasons to support the conclusion. Clarification is therefore respectfully requested.

The Office Action finally states that "[i]n the alternative, it would have been obvious to one of ordinary skill in the art to incorporate such with Baker." First, it is unclear whether this is intended to constitute a taking of Official Notice. If the Examiner intends to rely on Official Notice with respect to any of the limitations of the claims, then it is respectfully requested that the Examiner clarify the scope of the taking of Official Notice and that the Examiner provide evidence to support the Official Notice. Second, for reasons previously stated, Applicant respectfully disagrees. It is noted that this statement is merely conclusory and provides no reasons to support the conclusion. Clarification is therefore respectfully requested.

¹ *In Re Rijckaert*, 9 F.3d 1531, 1532 (CAFC 1993).

The Office Action includes no explicit taking of Official Notice. Thus, it can only be assumed that the Examiner relies solely on the teachings of Baker. However, if the Examiner intends to rely on Official Notice with respect to any of the limitations of the claims, then it is respectfully requested that the Examiner clarify the scope of the taking of Official Notice and that the Examiner provide evidence to support the Official Notice.

In light of the discussion above, it is respectfully submitted that claims 1-11, 34, and 35 are in condition for allowance. Accordingly, Applicants respectfully request that the rejection of claims 1-11, 34, and 35 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-11, 34, and 35 be allowed.

In the event that the Examiner remains unconvinced, the Examiner is invited to contact the undersigned Agent for Applicant by telephone at (817) 447-9955 so that the issue can be discussed and a resolution can be reached.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

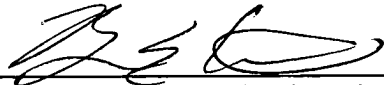
The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

28 Dec 2005

Date


James E. Walton, Registration No. 47,245
Daren C. Davis, Registration No. 38,425
Brian E. Harris, Registration No. 48,383
Michael Alford, Registration No. 48,707
Steven J. Laureanti, Registration No. 50,274
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
jim@waltonpllc.com (e-mail)

CUSTOMER NO. 53184
ATTORNEYS AND AGENTS FOR APPLICANT